

REMARKS

Claims 1-4, 6, 7, 9-15, 17, 18 and 22-24 are currently pending in the present application.

Applicants wish to extend their appreciation to Examiner Walters for withdrawing the rejections under 35 U.S.C. § 103(a).

The rejection of claims 1-4, 6, 7, 9-15, 17, 18 and 22-24 under 35 U.S.C. § 112, first paragraph (written description), is respectfully traversed.

The originally filed specification is alleged as failing to provide adequate written description for the negative limitation that “after the treatment with the cationic polymer the treated paper or paper product is not coated,” as recited in claim 1.

Pursuant to In re Wertheim, 541 F.2d 257, 265 (1976), the exact terms recited in the claimed invention need not be used *in ipsis verbis* or *in haec verba* in order to satisfy the written description requirement of 35 U.S.C. § 112, first paragraph. See also MPEP §§ 1302.01 and 2163.05(III). What is required is that the claimed invention must have been described with sufficient particularity such that a skilled artisan would recognize that the Applicants had possession of the claimed invention when the application was filed. See 35 U.S.C. § 112, first paragraph, and MPEP § 706.03(c).

With respect to negative limitation that after the treatment with the cationic polymer the treated paper or paper product is not coated, as recited in claim 1, the originally filed specification clearly describes that the aqueous solution comprising the cationic polymer is applied to the paper or to a coated paper “*after the final coat*” (emphasis added) and thereafter optionally dried and/or calendared (See e.g., page 5, lines 21-31). As exemplified in Examples 1-4 of the originally filed specification, ***no additional coating*** is applied to the paper or paper product after the treatment with the cationic polymer.

In addition, the originally filed specification and claims clearly disclose and recite that the aqueous solution comprising the cationic polymer is used as the “***sole treatment composition***” (emphasis added) (See e.g., page 2, lines 33-38, page 4, lines 38-40, and page 15, lines 6-9, as well as original claim 1).

Furthermore, based on the disclosure of the originally filed specification, a skilled artisan would immediately recognize that coating the paper or paper product with an additional coating after the treatment of the final coat with the aqueous solution comprising the cationic polymer would be ***counterproductive*** since the cationic polymer would be covered by the additional coating, thereby eliminating the beneficial effects imparted by the cationic polymer to the printability of the paper or paper product, with respect to the remarkably improved water resistance and water fastness of the ink-jet printed images printed thereon. Why would a skilled artisan ***invest time and incur undue expense*** to treat the final coat with the aqueous solution comprising the cationic polymer only to immediately thereafter cover the cationic polymer with an additional coating and thereby eliminate the beneficial effects imparted by the cationic polymer to the printability of the paper or paper product?

Applicants respectfully submit that a skilled artisan would immediately recognize that adequate support for the presently claimed invention has clearly been provided by the express, implicit and inherent disclosure set forth in the originally filed specification, as evidenced hereinabove. Since the specification describes the claimed invention in sufficient detail such that a skilled artisan would reasonably conclude that the inventors had possession of the claimed invention at the time of filing, the amendment to claim 1 has not resulted in the introduction of new matter.

Withdrawal of this ground of rejection is respectfully requested.

In conclusion, Applicants submit that the present application is now in condition for allowance and notification to this effect is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.



Richard L. Treanor
Attorney of Record
Registration No. 36,379

David P. Stitzel
Attorney of Record
Registration No. 44,360

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 07/09)